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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------------|---------------------|------------------|
| 09/891,888 | 06/26/2001 | Jean Fernand Armand Lacrampe | JAB-1626 | 4721 |

27777 7590 09/18/2002
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[REDACTED] EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1624 | 9 |

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/891,888 | LACRAMPE ET AL. |
| | Examiner | Art Unit |
| | Venkataraman Balasubramanian | 1624 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 June 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11, 12 and 15-22 is/are pending in the application.

4a) Of the above claim(s) 11, 12 and 15-22 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response, which included cancellation of claims 1-7,10, 13-14, and addition of new claims 15-22, filed on 6/26/2002, is made of record.

Claims 15-22 and 11-12 are in the case of which non-elected claims 11-12 were withdrawn from further consideration in the previous office action.

As for applicants' response, it is not clear whether the response is for the instant application or some either application. The title indicated in the response is totally different form the originally presented title and the subject matter is distinctly different as embraced in the title shown in the response.

Newly submitted claim 15-22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly presented claims are independent claims drawn to what appears to be a complex compositions with compound of various distinct genus. If these claims were originally presented they would have been subjected to restriction requirement.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

As for applicants' response the following apply:

Applicants' argument to over come the 112 rejections of claims 1-7,10, and 13-14 made in the previous office action, is not persuasive. Applicants argue that it is well

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known in the prior art that a skilled artisan to use protecting groups for reactive groups. First of all applicants are claiming a process, if it is well known then the process is would not be patentably distinct. Secondly, a skilled artisan would also know that putting a protective group selectively and then removing them selectively by no means trivial and would require experimentation. Furthermore, in the instant the protection of reactive haloalkyl group really requires a specialized process, which is not in the specification. Applicants' have not provided any reference to support that the protection of haloalkyl group is a routine process.

Hence the rejection is proper. However, applicants' cancellation of claims 1-7, 10 and 13-14 have rendered these rejections moot.

The following prior art rejection were also made in the previous office action:

Claims 1-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Boeckx et al. EP 0 232 932.

Claims 1-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Miki et al. EP 0 648 760.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boeckx et al. EP 0 232 932.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miki et al. EP 0 648 760.

Applicants' arguments to overcome these rejections are also not persuasive. Applicants assert that examiner picks and chooses among the variable substituents recited in these references to find compounds falling within the genera of the rejected

claims and that the cited references do not disclose, describe or suggest instantly claimed compounds.

This is a misplaced argument as it is proper to compare the instant compounds with reference compounds and show that all limitations embraced in the claims are met with in the reference. It is proper examination procedure. As for applicants' assertion, that the cited references do not disclose, describe or suggest instantly claimed compounds, applicants are asked to look at pages 14-22, 22-27 of Boeckx, pages 21-49, table 3 of Miki et al., both of which teach, and suggest the instant compounds

Hence, these rejections are proper. However, in view of applicants' cancellation of said claims, the rejections are rendered moot.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703)

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305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

9/15/2002